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10/757,255

01/14/2004

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04/20/2007

EXAMINER

KAYES, SEAN PHILLIP

ART UNIT

PAPER NUMBER

2833

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/757,255	Applicant(s) IPPOLITO ET AL.	
	Examiner Sean Kayes	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-8,10-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-8,10-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-4, 6-8, 10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Electro-Mech.

3. With respect to claim 1 Electro-Mech teaches a device for displaying information about a game with a playing surface, the device comprising:

- a body that is physically unconnected to the playing surface (figure 1)
- a first display operable to display first information about a player of the game ("Home", "Player", or "Fouls" figure 1) second information about the player of the game, and
- a second display ("Home", "Player", or "Fouls" figure 1) operable to display second information about the player of the game, the second display facing in a different direction from that of the first display (figure 1 shows a display facing in four directions),
- in which both the first display and the second display are rigidly attached to the body.

Art Unit: 2841

4. With respect to claim 3 Electro-Mech teaches a device for keeping time comprising:

- a single rigid chassis (figure 1);
- a first memory (pages 9-10 discuss setting of the clock. Electronic tracking of time inherently involves a memory.) for storing a first amount of time remaining for a first player of a game, the first memory attached to the chassis (page 3 "Scoreboard Electronics: 100% solid state fully enclosed");
- a first display ("88:" shown on the left face of figure 1 is the first display) for displaying the first amount of time, the first display rigidly attached to the chassis and coupled to the first memory;
- a second display ("88:" shown on the right face figure 1 is the second display) for displaying the first amount of time, the second display rigidly attached to the chassis and coupled to the first memory,
- a second memory storing a second amount of time remaining for a second player of the game ("Shot Timer" page 10), the second memory attached to the chassis (page 3 "Scoreboard Electronics: 100% solid state fully enclosed");
- a third display ("88" located under the word "Player" figure 1 or ":88" located on any face not previously considered as the first or second display while the display is in shot clock mode.) for displaying the second amount of time, the third display rigidly attached to the chassis and coupled to the second memory;
- a fourth display displaying the second amount of time, the fourth display rigidly attached to the chassis and coupled to the second memory (The fourth display is

the same as the third display but is located on a face different from that of the third display, shown in figure 1. If the shot clock is operated on the regular time section "88:88" than the fourth display is located on the face not previously designated as the first, second, or third displays.)

5. With respect to claim 4 Electro-Mech teaches the device of claim 3, in which the second display faces in a direction opposite that of the first display. (In this regard the "second display" would be considered to be the display directly opposite of the "88:88" display shown on the left face in figure 1.)

6. With respect to claim 5 Electro-Mech teaches the device of claim 3, in which the first display and the third display are the same display (this would be the case wherein the main time display "88:88" figure 1 is used to show the shot time), and in which this same display displays the first amount of time at a first location on the display and the second amount of time at a second location on the display (the first time being the hours of the remaining time, as shown on the left hand side of the "88:88" display. The second time would be the shot time or alternatively the seconds of the game as indicated by the right hand side of the "88:88" display. Although in the interpretation wherein the second time is the seconds of the game it would be understood that the first and second players of the game would be either the "Home" and the "Guest" teams or alternatively a first and second player of the same team.)

Art Unit: 2841

7. With respect to claim 7 Electro-Mech teaches the device of claim 3, in which the first memory and the second memory are the same memory, and in which this same memory stores the first amount of time in a first location in the memory and the second amount of time in a second location in the memory. (Page 3 states that the electronics of the Electro-Mech device is solid states and fully enclosed. Since the respective memories are necessarily in operational communication with one another they can be construed to be functionally the same memory. Furthermore since the electronics are solid state they necessarily store the memory information in different locations.)

8. With respect to claim 8 Electro-Mech teaches the device of claim 3, in which the first memory is a semiconductor memory (page 3 "Scoreboard Electronics: 100% solid state fully enclosed.")

9. With respect to claim 10 Electro-Mech teaches the device of claim 3, in which the first display is a light emitting diode display (page 13.)

10. With respect to claim 14 Electro-Mech teaches a device comprising:

- a means for tracking a first time ("Solid State Electronics" page 3 and hours of the time display "88:88" figure 1)
- a means for tracking a second time ("Solid State Electronics" page 3 and minutes of the time display "88:88" figure 1)

Art Unit: 2841

- a first display means for displaying the first time in a first direction (the left side of the time display "88:88" figure 1 shown on the left face of the scoreboard)
- a second display means (the left side of the time display "88:88" figure 1 shown on the right face of the scoreboard) for displaying the first time in a second direction; and
- an initiation means (figure page 9 shows the input means) for initiating the reduction of the first time and halting the reduction of the second time,
- in which the display means is a light emitting diode (figure 1 and page 13.)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Electro-Mech in view of Honekman (US 4567461.)

13. With respect to claim 13 Electro-Mech teaches the device of claim 3.

Electro-Mech does not teach a microphone for receiving voice inputs.

Honekman teaches a voice recognition function and microphone for the purposes of operating a gaming device by voice commands.

At the time of the invention it would have been obvious to one skilled in the art to provide Electro-Mech's device with a microphone and corresponding voice recognition

software so as to allow voice communication control of the device as taught by Honekman.

The suggestion or motivation for doing so would be to allow a user to operate the device by voice communication as taught by Honekman.

14. Claims 3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garlock (US 20020093882) in view of Electro-Mech.

15. With respect to claim 3 Garlock teaches a device for keeping time comprising:

- a single rigid chassis (2 figure 1)
- a first memory (page 4 column 1 paragraph 43 discusses wherein the timing values are stored in a memory. Additionally, see claim 12.) for storing a first amount of time remaining for a first player of a game (left display, 4 figure 1), the first memory attached to the chassis
- a first display (left display, 4 figure 1) for displaying the first amount of time, the first display rigidly attached to the chassis and coupled to the first memory
- a second memory (page 4 column 1 paragraph 43 discusses wherein the timing values are stored in a memory. Additionally, see claim 12.) storing a second amount of time remaining for a second player of the game, the second memory attached to the chassis
- a third display (right display figure 1) for displaying the second amount of time, the third display rigidly attached to the chassis and coupled to the second memory; and

Garlock does not teach

- a second display for displaying the first amount of time, the second display rigidly attached to the chassis and coupled to the first memory,
- a fourth display for displaying the second amount of time, the fourth display rigidly attached to the chassis and coupled to the second memory and
- wherein the second display faces in a different direction from that of the first display.

Electro-Mech teaches attaching multiple game information boards together for the purpose of increasing the visibility of the information displayed on said surfaces in multiple directions.

At the time of the invention it would have been obvious to one skilled in the art to provide Garlock's invention with multiple displays facing in multiple directions as taught by Electro-Mech. The suggestion or motivation for doing so would be to indicate displayed information in more than one direction.

16. With respect to claim 11 Garlock (US 20020093882) and Electro-Mech teach the device of claim 3 further including:

- a signal generator (page 2 paragraph 14) for generating a timing signal, the signal generator coupled to the first memory and to the second memory;
- a first button (left button, 8 figure 1) for signaling a first play in the game, the first button attached to the chassis and coupled to the first memory and to the second memory; and

- a second button (right button 8 figure 1) for signaling a second play in the game, the second button attached to the chassis and coupled to the first memory and to the second memory, in which:
- the first memory is operative to reduce the first amount of time remaining upon receipt of signals from the second button (paragraph 39 page 3);
- the first memory is operative to stop reducing the first amount of time remaining upon receipt of signals from the first button (paragraph 39 page 3);
- the second memory is operative to reduce the second amount of time remaining upon the receipt of signals from the first button (paragraph 39 page 3); and
- the second memory is operative to stop reducing the second amount of time remaining upon receipt of signals from the second button (paragraph 39 page 3);
- the motion of the first button with respect to the chassis is constrained to one dimension (figure 1); and
- the motion of the second button with respect to the chassis is constrained to one dimension (figure 1.)

17. With respect to claim 12 Garlock and Electro-Mech teach the device of claim 3, further including a processor (18 figure 2), the processor attached to the chassis (2 figure 1) and operative to: direct the first memory (see claim 12 lines 9-10) to reduce the first amount of time remaining; direct the second memory (see claim 12 lines 9-10 and second display shown in figure 1) to reduce the second amount of time remaining; direct the first memory to stop reducing the first amount of time remaining; direct the second

memory to stop reducing the second amount of time remaining; direct the first display to display the first amount of time; and direct the second display to display the first amount of time (paragraphs 33, 39, 43-44, and 46-47.)

18. Claims 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garlock (US 20020093882) in view of Adams (US 5125666.)

19. With respect to claim 16 Garlock teaches a device comprising:

- a body (2 figure 1)
- a memory (see claim 12), including two memory locations, in which each of the two memory locations stores a time remaining for a different one of two players; and
- exactly two clock buttons (8 figure 1), each of which when pressed halts the reduction of a first one of the times remaining stored in a first one of the two memory locations and initiates the reduction of a second one of the times remaining stored in a second one of the two memory locations, in which the memory and each of the two clock buttons are attached to the body.

Garlock does not teach the system designed for four players, including four memory locations, and exactly four buttons. Garlock's timing device is designed for exactly two players instead of four.

Four player games are well known in the art. Evidence of four player games is provided by Adams. Adams teaches a four-player version of chess. Adams additionally teaches the necessity for timing a four-person game of chess (column 5 lines 4-22.)

Art Unit: 2841

At the time of the invention it would have been obvious to one skilled in the art to modify Garlock's invention to time four players instead of two by increasing the number of buttons and memory locations to four instead of two. The suggestion or motivation for doing so would be to allow the device to be used to time Adams's four-player version of chess.

20. With respect to claim 17 Garlock and Adams teach the device of claim 16, further including four display, in which each display is operable to display one of the times remaining (4 figure 1), and in which each display is attached to the body (2 figure 1.)

21. With respect to claim 19 Garlock and Adams teach the device of claim 16, further including:

- a first display (4 figure 1) operable to display a first and second of the times remaining (first time "120:" and second time ":00"); and
- a second display (the right display "120:00" of figure 1) operable to display a third and fourth of the times remaining (third time "120:" fourth time ":00");
- in which the first display and the second display are attached to the body (2 figure 1.)

Alternatively to the interpretation provided above the first display could be construed to be item 6 figure 1 and the first time would be item 4 figure 1 the second time would be the display on the right side "120:00." The second display would be the modification

Art Unit: 2841

mentioned in the rejection to claim 16 (in view of Adams) wherein the device is provided two additional displays for tracking four player times.

22. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garlock (US 20020093882) in view of Adams (US 5125666) and Chodak (US 4363489.)

23. With respect to claim 18 Garlock and Adams teach the device according to claim 17.

Neither Garlock nor Adams teaches providing displays on two separate faces wherein the two faces are directed in different directions.

It is well known in the art to provide displays that display information in multiple directions. This is particularly so in the case of four player games, such as that taught by Adams. Chodak teaches such a four directional display for a four-person game.

At the time of the invention it would have been obvious to one skilled in the art to provide Garlock's device with at least two display faces facing in different directions, as taught by Chodak.

The suggestion or motivation for doing so would be to increase visibility of the displayed information, particularly for players in a multiple player game.

24. Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garlock (US 20020093882) in view of applicant's admitted prior art and Yoo.

25. With respect to claim 16 Garlock teaches a device comprising:

- a body (2 figure 1)

Art Unit: 2841

- a memory (see claim 12), including two memory locations, in which each of the two memory locations stores a time remaining for a different one of two players; and
- exactly two clock buttons (8 figure 1), each of which when pressed halts the reduction of a first one of the times remaining stored in a first one of the two memory locations and initiates the reduction of a second one of the times remaining stored in a second one of the two memory locations, in which the memory and each of the two clock buttons are attached to the body.

Garlock does not teach the system designed for four players, including four memory locations, and exactly four buttons. Garlock's timing device is designed for exactly two players instead of four.

In applicant's discussion of the background art, applicant states that multiple clocks are used per table to track multiple games of chess (paragraph 7 page 1. Particularly, the last 5 lines of page 1 and the first two lines of page 2.)

At the time of the invention it would have been obvious to one skilled in the art to use more than one of Garlock's devices for the purpose of tracking multiple games of chess, as per applicant's discussion of general tournament play. The suggestion or motivation for doing so would be to time more than one game at a time as per applicant's admitted prior art.

It is notoriously well known to house multiple devices in a single housing. Evidence of this is provided by Yoo. Yoo teaches two clocks for displaying separate times.

Additionally, the courts have ruled that forming in one piece an article which has formerly been formed in two pieces would require only ordinary skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

At the time of the invention it would have been obvious to one skilled in the art to combine two of Garlock's devices in a common housing. To do so would require only ordinary skill in the art, as supported by the teaching of Yoo and the ruling of *Howard v. Detroit Stove Works*. The suggestion or motivation for doing so would be to indicate and track more than one time in a common device, as taught by Yoo.

26. With respect to claim 20 Garlock, Yoo, and applicant's admitted prior art teach the device of claim 16, with the four clock buttons referred to as A, B, C, and D and with the four memory locations referred to as w, x, y, z, in which: clock button A, when pressed, halts the reduction of the time remaining stored in memory location w, and initiates the reduction of the time remaining stored in memory location x, clock button B, when pressed, halts the reduction of the time remaining stored in memory location x, and initiates the reduction of the time remaining stored in memory location w; clock button C, when pressed halts the reduction of the time remaining stored in memory location y, and initiates the reduction of the time remaining stored in memory location z; clock button D, when pressed halts the reduction of the time remaining stored in memory location z, and initiates the reduction of the time remaining stored in memory location y; neither clock button A nor clock button B has any effect on times remaining in memory locations y and z; and neither clock button C nor clock button D have any effect

Art Unit: 2841

on time remaining in memory locations w and x. (Figure 1 shows the control buttons, 8, and the two time displays for indicating each player time. Paragraph 39 discusses wherein pressing one of the buttons, 8 figure 1, will start decreasing the time stored in a given players memory. Paragraph 43 states wherein the time variables are assigned to memory locations. As modified in the previous action the two clocks would function essentially separately not modifying the other clock's memory.)

Response to Arguments

27. Applicant's arguments filed 3/5/07 have been fully considered but they are not persuasive. Additionally, the grounds of rejection to many of the claims have been changed in order to more completely address applicants concerns. Those arguments, which have subsequently been rendered moot in view of the new grounds of rejections, are addressed below.

28. Applicant's first argument is that there is no motivation for combination of the references of Garlock and Dennison. The new grounds of rejection have rendered this argument moot. However, for the sake of clarity the argument has been addressed as follows: Applicant supports this claim by asserting that the game of chess is different from the game disclosed by Dennison because the timer is traditionally placed to the side of the board game. The applicant further states that since the timer being placed to side of the board allows both players to see the timer there is no motivation for providing a display of the type taught by Dennison. This, however, is only a partial consideration of the matter. Admittedly a clock located at the side of a chessboard is conceivably

Art Unit: 2841

visible to both players of the game of chess, provided that they are sufficiently close to the board that the clock is substantially perpendicular to their viewing angle. This does not, however, negate the teaching of Dennison. Moreover, the side located clock is not the ideal of the two solutions. A display that faces in only one direction cannot indicate information in two opposite directions (directions at an angle of 180 degrees from one another.) Although as applicant has pointed out a single facing directional display can indicate said information in two different directions (i.e. at angles substantially less than 90 degrees from the indication direction.) The suggestion or motivation for combination is to resolve this issue allowing players to view the displayed information while facing in opposite directions (180 degrees.)

29. The applicant further reinforces the point of the first argument by asking the question "Why should Garlock create a display facing in the opposite direction if both game players can already see the display disclosed by Garlock?" The reason is to make an improvement to the current system. While the system proposed by applicant is functional it does not represent the best solution. The mere assertion that status quo is functional does not negate the teaching of Dennison. Moreover, the status quo of the invention would not motivate one skilled in the art to overlook the improvements taught by Dennison.

30. Applicant's second argument states that Kifer does not teach timing the four-person version of chess. The motivation for timing is provided by Garlock. Garlock teaches a timer for timing multiple players. Moreover the primary concern of Garlock's invention is timing of games. Kifer merely provides a game that utilizes four players.

Art Unit: 2841

However, in light of applicant's concern the grounds of rejection have been changed.

The current rejection is based on Garlock in view of Adams, wherein Adams teaches both a four-player version of chess as well as the need to time said game.

31. Applicant's third argument states that the combination of Kifer and Garlock does not arrive at the claimed invention. This is not persuasive as the claimed invention can be met by two of Garlock's inventions laid side by side. It has been held that the mere duplication of parts does not render an invention patentable.

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)

What is lacking in the Garlock reference is a motivation or reason to have two such clocks. This limitation is addressed by the existence of a four-person game, namely four person chess taught by Kifer (or Adams according to the current grounds of rejection.)

32. Applicant's fourth argument states that although applicant admits that multiple games are tracked in tournament play applicant does not admit as part of the prior art that there is motivation to track said multiple games on a single device. It has been held that forming in one piece an article which has formerly been formed in two pieces would require only ordinary skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Moreover, the Yoo reference teaches combining two clocks into a common housing.

Applicant provides further support for this position by stating that there are lots of devices that are separate that for good reason would not be combined. The example provided being a pair of shoes. This, however, does not negate the teaching of Yoo which teaches combining two clocks into a common housing.

Art Unit: 2841

Applicant is thanked for the example of the shoes. Said example made very clear applicant's position. However, said argument is not persuasive. In said example shoes are routinely attached together by the laces such that the can be hung from a hook, wire, or other such attachments.

33. Applicant's fifth argument is that there may be reasons that teach away from combining the elements of Garlock. Applicant is probably correct to assert that somewhere somehow there is a reason for not providing two integrally formed devices as taught by Garlock and Yoo. This is not however persuasive argumentation. Applicant provides several reasons why the combination may be undesirable, however none of these reasons are discussed in any of the references of record. Therefor it is hard to understand how on of ordinary skill in the art would have been motivated by said reasons at the time of the invention. Moreover, the reasons do not negate the teachings of Garlock and Yoo nor do they overturn the establish record of the courts namely the ruling of *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Kayes whose telephone number is (571) 272-8931. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Paula can be reached on (571) 272-2800. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2841

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SK
3/30/2007



Vít Miska
Primary Examiner